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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,944	02/04/2002	Ezequiel Mejia	135695/0055	5578

7590 12/31/2003
STROOCK & STROOCK & LAVAN LLP
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New York, NY 10038-4982

EXAMINER

CLINGER, JAMES C

ART UNIT PAPER NUMBER

2821

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/066,944	MEJIA ET AL.	
	Examiner	Art Unit	
	Jim Clinger	2821	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s), _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, the limitation "a core" is indefinite because no limitations have been recited to define this element.

Claim 8, the limitation "flip chip technology" is vague because it is not recited or clear what devices constitute this technology and what devices do not constitute this technology.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al.(4,727,360) in view of Stafford et al.(5,482,008).

Claim 1, figure 1A of Ferguson discloses a core(10) for use in a passive integrated transponder tag(abstract) extending substantially the entire length of a transponder tag. Ferguson does not disclose the core comprising a coil receiving portion and an electronics support portion. Figure 15 of Stafford discloses a core(34) with a receiving coil portion(6) and an electronics(5) support portion for a smaller device like a tag(col. 5, lines 42-64).

Claims 2 and 6, figure 15 of Stafford discloses an electronics support portion that is adapted to support an integrated circuit(5) connected to an antenna coil(6).

Claim 3, figure 11 of Stafford discloses an electronics support portion further comprising a card with a metalization layer(33) formed therein or thereon.

Claim 4, figure 11 of Stafford discloses the electronics support portion further comprises one or more metal pads formed therein or thereon(not numbered, connection points).

Claim 5, figure 15 of Stafford discloses an antenna coil(6) wound about said coil receiving portion and electronically connected to a metalization layer or a metal pad formed on or in said electronics support portion.

Claim 7, figure 11 of Stafford discloses an integrated circuit(5) and antenna coil(6) which are each electrically connected to said metalization layer or metal pad(33).

Claim 8, integrated circuit flip-chip technology is well known in the art and its use with the disclosed device would be an obvious modification of the device.

Claim 9, the IC(5) disclosed in Stafford would include a surface mounted capacitor thereon.

Claim 10, the core(34) disclosed in Stafford is made of ferrite.

Claim 11, figure 15 of Stafford discloses an encapsulation(80) means enclosing the core(34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the coil and core disclosed in Stafford with the tag disclosed in Ferguson so the device can be made smaller.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 of U.S. Patent No. 6,400,338. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of this application are a mostly broader version of the claims recited in U.S. Patent No. 6,400,338.

Claim 1, claim 1 of '338 recites a core for use in a passive integrated transponder tag extending substantially the entire length of a transponder tag comprising a coil receiving portion and an electronics support portion.

Claims 2 and 6, claim 1 of '338 recites an electronics support portion that is adapted to support an integrated circuit connected to an antenna coil.

Claim 3, claim 2 of '338 recites an electronics support portion further comprising a card with a metalization layer formed therein or thereon.

Claim 4, claim 4 of '338 recites a PCB which would have one or more metal pads formed therein or thereon.

Claims 5 and 7, claims 7-9 of '338 recite an antenna coil wound about said coil receiving portion and electronically connected to a metalization layer or a metal pad formed on or in said electronics support portion.

Claim 8, the recited limitations are not considered because of the above 35 USC 112 rejection.

Claim 9, claim 10 of '338 recites a surface mounted capacitor thereon.

Claim 10, claim 3 of '338 recites a core made of ferrite.

Claim 11, claim 6 of '338 recites an encapsulation means enclosing the core.

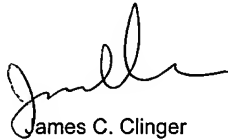
Correspondence

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jim Clinger whose phone number is (703) 305-0619.

Art Unit: 2821

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center whose telephone number is (703) 308-0956.

Papers related to Technology Center 2800 applications only may be submitted to Technology Center 2800 by facsimile transmission. Any transmission not to be considered an official response must be clearly marked "DRAFT". The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Technology Center Fax Center number is (703) 872-9306.



James C. Clinger